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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/646,483 | 08/22/2003 | John William Vogler | 71602 | 9445 |

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EXAMINER

GOFF II, JOHN L

ART UNIT PAPER NUMBER

1733

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/646,483

Applicant(s)

VOGLER ET AL.

Examiner

John L. Goff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-9, 11-15 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 11-15 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>6/26/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed on 6/26/06.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

3. Claims 17 and 18 are objected to because of the following informalities: In claim 17, line 1 delete "16" and insert therein - - 12 - -. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
5. Claims 1-5, 8, 11-14, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cobb (U.S. Patent 3,025,861) in view of McIntosh (U.S. Patent 1,631,750).

Cobb discloses a method of making a cigarette filter comprising providing a first component of an aggregation of cellulose acetate fibers, exposing the aggregation of fibers to a

plasticizing solvent (e.g. triacetin, dimethoxy ethyl phthalate, etc.), providing a paper, coating a side of the paper with cellulose acetate to form a second component, wrapping the aggregation of fibers with the paper to form a compound structure, and curing the compound structure to bond the paper to the aggregation of fibers thereby forming a cigarette filter (Figures 1 and 2 and Column 1, lines 10-16 and Column 2, lines 8-10 and 43-67 and Example II and Column 4, lines 67-75 and Column 5, lines 1-7 and 36-39). Cobb is silent as to the paper having the cellulose acetate incorporated therein. McIntosh discloses a method of forming paper having cellulose acetate incorporated therein comprising incorporating the cellulose acetate into the pulp fibers when forming the paper whereby incorporating the cellulose acetate into the paper as opposed to coating the paper with a resin intimately and uniformly disperses the cellulose acetate throughout the fibers of the paper as well as on the surface of the paper to form a more moisture repellant and durable product with the further advantage of not having to have a step of coating the paper with the resin in a process of bonding with the paper (Page 1, lines 4-40). It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the second component comprising paper and cellulose acetate as taught by Cobb using the method of forming paper having cellulose acetate incorporated therein as shown by McIntosh such that the paper for wrapping the aggregation of fibers is improved in moisture repellency and durability and has the further advantage of eliminating the step of coating the paper with the cellulose acetate.

Regarding claim 13, Cobb is silent as to additional applications of the plasticizing solvent to the aggregation of fibers and/or paper including cellulose acetate. However, the plasticizing solvent is included to lower the melting point of the cellulose acetate in the aggregation of fibers

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and paper to affect a rapid sealing between the two (Column 4, lines 39-46). Absent any unexpected results, it would have been obvious to one of ordinary skill in the art at the time the invention was made to experimentally determine the required number of applications of plasticizing solvent as taught by Cobb as modified by McIntosh as a function of the ability to affect a rapid sealing between the aggregation of fibers and paper as doing so would have required nothing more than ordinary skill and routine experimentation.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cobb and McIntosh as applied to claims 1-5, 8, 11-14, and 17-21 above, and further in view of Pearman (U.S. Patent 3,426,764).

Cobb and McIntosh as applied above teach all of the limitations in claim 7 except for a specific teaching that the pulp fibers that form the paper are cellulose fibers. Pearman discloses a method of forming paper having cellulose acetate incorporated therein comprising incorporating the cellulose acetate into the pulp fibers when forming the paper wherein the pulp fibers are cellulose fibers (Column 3, lines 40-43). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the pulp fibers of the paper taught by Cobb as modified by McIntosh those formed from cellulose as was well known in the art and shown by Pearman as only the expected results would be achieved.

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7. Claims 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cobb and McIntosh as applied to claims 1-5, 8, 11-14, and 17-21 above, and further in view of Cobb et al. (U.S. Patent 3,106,501).

Cobb and McIntosh as applied above teach all of the limitations in claims 9 and 15 except for the particular technique for applying the plasticizing solvent to the aggregation of fibers. Cobb et al. disclose a method of making a cigarette filter comprising providing an aggregation of cellulose acetate fibers, exposing (e.g. by spraying) the aggregation of fibers either before or after condensing to a plasticizing solvent (e.g. triacetin, dimethoxy ethyl phthalate, etc.), providing a paper, and wrapping the aggregation of fibers with the paper (Figures 2, 5, and 6 and Column 4, lines 29-57 and Column 5, lines 10-23). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the plasticizing solvent as taught by Cobb as modified by McIntosh by spraying as was well known in the art and shown by Cobb et al. as only the expected results would be achieved.

Response to Arguments

8. Applicant's arguments with respect to claims 1-5, 7-9, 11-15, and 17-21 have been considered but are moot in view of the new ground(s) of rejection. In view of applicants amendment to require the second component comprise paper having a cellulose ester incorporated therein the previous rejections are withdrawn and new rejections addressing the new limitation are made above.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571) 272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

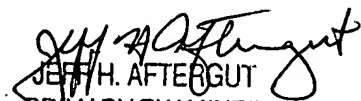
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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